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08/729,341	10/16/1996	OPHIRA R. AHARONSON		3864
41840	7590	11/14/2007		
RINES & RINES 24 Warren St. CONCORD, NH 03301			EXAMINER LIANG, REGINA	
			ART UNIT 2629	PAPER NUMBER
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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 08/729,341  
Filing Date: October 16, 1996  
Appellant(s): AHARONSON ET AL.

**MAILED**

**NOV 14 2007**

**Technology Center 2600**

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Robert H. Rines  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 10/1/07 appealing from the Office action mailed 2/22/07.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-11, 20-42 and 57-58 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Independent claims 1 and 32 copied from Cotte's reference (U.S. Patent No. 5,499,108) recite "wherein said placement alone is sufficient to initiate said drawing, and said computer comprising means for displaying, in response to said placement, a plurality of user-selectable options for processing said image data". However, there is no description in the specification to support the feature of the placement alone is sufficient to initiate said drawing nor means for displaying, in response to said placement, a plurality of user-selectable options for processing said image data. The closest disclosure in the specification is as follows:

(a) Figure 1 of the application shows a monitor (H2), but does not disclose the feature of " means for displaying, in response to said placement, a plurality of user-selectable options for processing said image data".

(b) On page 18, lines 14-18 of the specification discloses a master mode which the scanner automatically starts scanning, but does not discloses the limitations "means for displaying, in response to said replacement, a plurality of user-selectable options for processing said image data".

(c ) On page 22, last line to page 23, line 2, discloses that "the user may choose to use a scanner for data input by picking operation from a menu or typing a specification", but does not disclose the feature " means for displaying, in response to said placement, a plurality of user-selectable options for processing said image data". For example, the specification does not

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disclose a menu displayed on the screen. The menu mentioned in the specification may be placed on the keyboard before replacement. Even the menu of the specification is displayed on the monitor, but the specification does not disclose the limitation "means for displaying, in response replacement..."

No where in the specification discloses the limitation "means for displaying, in response to said placement, a plurality of user-selectable options for processing said image data".

Dependent claims 8-9 and 23-24 recite the limitations "'scanning means sends an interrupt to said computer in response to said replacement" and "'said image data periodically polls said input device". However, nowhere in the specification discloses such limitation above. Page 18, lines 14-18 of the specification describes a master mode with the host receives the scanned data into "spool" directory where it is stored for application to retrieve it, but does not mention the limitations "interrupt" nor "periodically polls" as recited in the claims.

Independent claims 20 and 26 recite the limitation "a plurality of user selectable options for processing said image data wherein said placement alone is sufficient to initiate display of said options". Again, nowhere in the specification discloses this limitation for the same reason as addressed in claim 1.

Independent claim 57 has similar problem as previously discussed on the independent claims 1, 20, 26 and 32 above. No where in the specification discloses "wherein said inserting is sufficient to initiate said drawing, and said computer comprising means for displaying the scan image data and means operable in response to said inserting of the document for initiating communications protocol with the computer for a plurality of user-selectable options for processing said image data" as recited in claim 57. It is noted that claims 57-58 recite the same

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limitation as claims 1-2 as stated by applicant on page 10 of the Remarks filed on February 11, 2004. That is “newly presented claims 57 and 58 precisely track claims 1 and 2”.

The remaining claims 2-11, 21-25, 27-31 and 33-42, 58 are rejected to as being dependent upon a rejected base claims.

In view of lacking written description, no art rejection has been applied since the specification does not support the limitations recited in the claims 1-11 and 20-42, 57, 58.

#### **(10) Response to Argument**

Appellants argue they are unable to find these specific words “in response to” and “responsive to” as claimed, either defined in or even used in the Cotte patent specification (page 11 of the brief), then appellants pick and chose to compare the Cotte et al Patent Structure with Appellants’ Structure (pages 12-18 of the brief), and then conclude the substantial identity of the Cotte et al disclosure and operation and that of the appellants (page 18 of the brief), and fail to consider or appreciate Cotte et al’s specification as a whole therefore these argument are not persuasive. Appellants appear not to give any credits to the examiner who issued the Cotte Patent. Furthermore, appellants are attempting to mislead the office, the question at issue is whether appellants’ specification provides support for the claims and not whether the patentee’s specification has support or not. All the sections as cited by applicants in applicants’ specification are all taken out of context by have pick and chose from two separate operating modes and concluded that these sections teach the claimed invention, however these cited sections do not find any support for “wherein said placement alone is sufficient to initiate said drawing, and said computer comprising means for displaying, in response to said placement, a plurality of user-selectable options for processing said image data” as claimed. The specification

does not disclose the COMBINATION of (1) scanning based on placement alone AND automatically (2) displaying a plurality of user-selectable options in response to the placement, as recited in all of the independent claims.

As to the declarations of Ralph Rodrigues and Dov Aharanson, both declarations have been fully considered and the declarations are not persuasive because both declarations do not provide any evidences to support the feature of automatic displaying of a plurality of user-selectable options in response to the placement along is find within applicants' specification and the statements in the declarations are nothing more than conclusions and opinions. The Rodrigues declaration references sections in appellants' specification for the operation of the slave mode where a menu is provided so that the **"user may choose to use a scanner for data input"** (emphasis added by examiner), it fails to provide any evidences that the specification supports the feature of automatic displaying of a plurality of user-selectable options in response to the placement along.

The remarks on pages 23-25 were previously addressed in the 5/5/2004 & 6/13/06 Office actions and were found to be non-persuasive. Those remarks are incorporated by reference herein.

For the above reasons, it is believed that appellants' remarks are not persuasive.

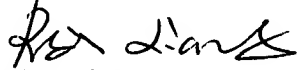
#### **(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

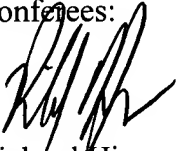
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Respectfully submitted,

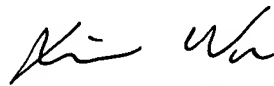


Regina Liang  
Primary Examiner  
AU 2629

Conferees:



Richard Hjerpe (SPE)  
AU 2629



Xiao Wu (SPE)  
AU 2628